



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,743	10/27/2003	Cheryl Phillips	34250-1102	6300
7590	01/22/2009		EXAMINER	
Malvern U. Griffin III			REFAI, RAMSEY	
SUTHERLAND ASBILL & BRENNAN LLP				
999 Peachtree Street, N.E.			ART UNIT	PAPER NUMBER
Atlanta, GA 30309-3996			3627	
			MAIL DATE	DELIVERY MODE
			01/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/696,743	Applicant(s) PHILLIPS ET AL.
	Examiner Ramsey Refai	Art Unit 3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 07 January 2009.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-45 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 01/07/09
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Response to Amendment

Responsive to Request for Continued Examination (RCE) filed January 7, 2009. Claims 1, 9, 17, 27, and 37 have been amended. Claims 1-45 remain pending.

Response to Arguments

1. Applicant's arguments have been fully considered but they are not persuasive.

In the remarks, the Applicant argues with substance:

Argument A: Goeller fails to teach "*wherein each of the plurality of user selectable identifiers is predefined by the merchant prior to electronically processing the check*".

In response, the Examiner respectfully disagrees. Goeller teaches that the transaction is formatted into a check authorization message and one of three service options is selected automatically or manually by the merchant. The message includes a processing code to identify the service transaction that the merchant desires. The limitation "predefined by the merchant prior to electronically processing the check" is not clearly defined in the Applicant's specification. Due to the broad nature of this limitation, the step of the merchant *selecting* the identifier prior to the check transaction meets the scope of this limitation (see at least paragraphs [0040, 0057-0059], Tables 1 and 2).

Argument B: Goeller fails to disclose or suggest the use of "*a plurality of user selectable identifiers associated with the merchant, wherein each of the plurality of user selectable identifiers is assigned to at least one selected type of check transaction*".

In response, the Examiner respectfully disagrees. Goeller teaches that the transaction is formatted into a check authorization message and one of three service options is selected automatically or manually. The message includes a processing code to identify the service

transaction that the merchant desires (**see at least paragraphs [0040, 0057-0059], Tables 1 and 2**).

Argument C: the service options are "not identifiers associated with the merchant"

In response, The Examiner respectfully disagrees and asserts that the identifiers are selected by the merchant and therefore are associated with the merchants desired transaction type.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on January 7, 2009 is being considered by the examiner.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to include the limitation *wherein the identifier is predefined by the merchant prior to processing the payment*; however it appears that this limitation lacks proper support in the Applicant's specification and appears to be new matter. It is also noted that term *predefined* is not mentioned nor defined in the Applicant's specification.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Goeller et al (US Publication No. 2002/0178112).

7. As per claim 1, Goeller et al teach a system for electronically processing a check received by a merchant, comprising:

a point-of-sale device that electronically converts the check and wherein the point-of-sale device allows such electronic conversion of the check (**see at least paragraphs [0012, 0039-0040]; POS used to convert paper checks into electronic fund transactions**) under one of a plurality of user selectable identifiers associated with the merchant; wherein each of the plurality of user selectable identifiers is assigned to at least one selected type of check transaction and wherein each of the plurality of user selectable identifiers is predefined by the merchant prior to electronically processing the check (**see at least paragraphs [0040, 0057-0059], Tables 1 and 2**);

a check processing service linked to the point-of-sale device to receive information about the converted check from the point-of-sale device (**see at least paragraph [0039]; POS check service**) wherein the check processing service performs an authorization process on the check and notifies the merchant via the point-of-sale device of an authorize or decline decision

depending on the identifier under which the check was converted (**see at least paragraphs [0040, 0057]**);

wherein at least one of the plurality of user selectable identifiers causes the point-of-sale device and

the check processing service to convert and authorize the check as an accounts receivable check (**see at least paragraphs [0081-0082, 0096]**) in a manner that is different than that for a check received in a face-to-face transaction (**see at least paragraphs [0091-0096; non-face to face transactions]**).

8. As per claim 2, Goeller et al teach wherein the point-of-sale device comprises a location-base device (**see at least paragraph [0049, 0054]**).

9. As per claim 3, Goeller et al teach wherein the electronic conversion of the check comprises scanning of the check to read the check's magnetic ink character recognition line and to obtain an image of at least a portion of the check (**see at least paragraphs [0039, 0049]**).

10. As per claim 4, Goeller et al teach wherein the plurality of user selectable identifiers includes an option on the point-of-sale device that, when selected, puts the point-of-sale device into a mode for processing accounts receivable checks (**see at least paragraph [0039, 0049]**).

11. As per claim 5, Goeller et al teach wherein the point-of-sale device in the accounts receivable mode facilitates the check processing service keeping track of accounts receivable checks processed (**see at least paragraph [0081, 0106]; settlement total**).

12. As per claim 6, Goeller et al teach wherein the point-of-sale device in the accounts receivable mode does not issue a check transaction receipt for the accounts receivable check (**see at least paragraphs [0091-0096; POS device does not issue receipts for non-face to face transactions]**).

13. As per claim 7, Goeller et al teach wherein the check processing service authorizes or declines the check by performing a risk assessment of the check (**see at least paragraphs [0040-0041]**).
14. As per claim 8, Goeller et al teach wherein the check processing service performs the authorization process and notifies the merchant of its decision in a manner that depends at least on a level of service subscribed by the merchant wherein the level of service includes the check processing service guaranteeing or purchasing check transactions it authorizes thereby assuming at least some of the risk associated with the check (**see at least paragraphs [0041]**).
15. As per claim 9-45, these claims contain similar limitations as claims 1-8 above, therefore are rejected under the same rationale.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers/paragraph numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai
January 20, 2009
/Ramsey Refai/
Examiner, Art Unit 3627